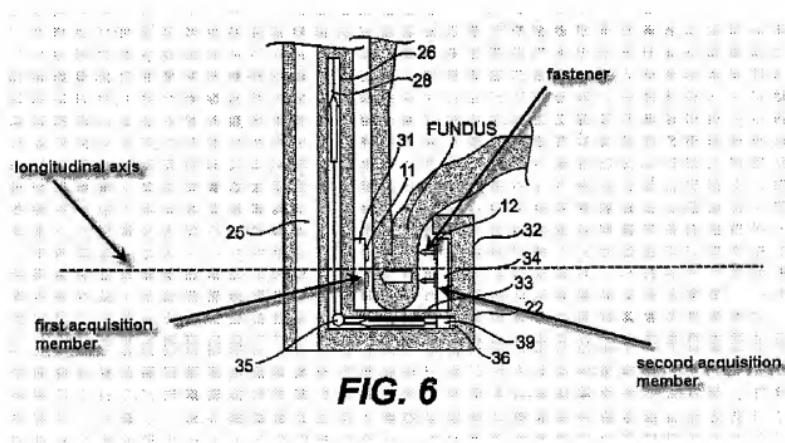


## REMARKS

Claims 44-52 are pending in the application. Claims 53 – 60 and 100 – 117 have been withdrawn pursuant to the restriction requirement. Claims 44 – 52 stand rejected in the Office Action of October 29, 2008 as being anticipated by Geitz, U.S. Patent No. 6,592,596. Applicant has carefully reviewed the Office Action and the cited references, and respectfully request reconsideration of the Claims in view of the remarks presented below.

### **Rejection of Claim 44 Under 35 U.S.C. §102(b)**

The Office Action rejected Claim 44 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,592,596 to Geitz. Geitz is directed to a device and method for using a two piece clip to engage and retain a fold in a portion of tissue. The Office Action relies on a version of FIG. 6 of the Geitz that is reproduced below for convenience.



Anticipation under 35 U.S.C. §102 requires **identity of invention**: the claimed invention, as described in appropriately construed claims, must be the same as that of the

reference, in order to anticipate. Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1267, 20 USPQ2d 1746, 1748 (Fed.Cir. 1991); see also In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed.Cir. 1990) (“the reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it”). The question becomes whether the disclosure of Geitz demonstrated every claimed feature of Claim 44 exactly as Claim 44 specifies. If not, then there can be no rejection for anticipation. For the reasons set forth below, Applicant respectfully contends that it does not.

Claim 44 is reproduced below:

44. A method of acquiring tissue from within a hollow body organ, comprising:  
positioning a first acquisition member and a second acquisition member adjacent to a region of tissue within the hollow body organ, wherein the first and second acquisition members are in apposition to one another along a first longitudinal axis in an open configuration;  
adhering tissue from the region within each of the first and second acquisition members; and  
compressing the adhered tissue between the first and second acquisition members in a closed configuration.

**a first acquisition member**

Claim 44 calls for positioning a **first acquisition member**, and adhering tissue from the region **within** the first acquisition member. The Office Action contends that Geitz teaches a first acquisition member is "sliding clip holder 34". Applicant respectfully submits that this contention is unsupported in the record. There is nothing that supports the position that the outer clip holder of Geitz is an acquisition member as used in the claim. This is particularly evident when one considers that the first acquisition member must adhere tissue **within** the acquisition member. There is nothing in the Geitz reference that supports the contention that the clip holder 34 adheres or could adhere tissue **within** the clip holder. Rather, Applicant respectfully submits that the clip holder only serves to retain the male portion of the two piece clip, which also lacks any description that would meet the claimed retention. The Office Action merely recites the

claim language without any discussion or explanation as to how the clip holder or the clip itself meets the claim limitations where tissue is retained "within." As the burden is on the Office Action to demonstrate anticipation, and no evidence has been proffered to satisfy the burden, Applicant respectfully submits that a *prima facie* rejection for anticipation has not been established.

**a second acquisition member**

The presence of the claimed **second acquisition member** is even more in doubt. Like the first acquisition member, the second acquisition member must adhere tissue within a region thereof. The Office Action points to the "**stationary clip holder 31**" as satisfying this claim limitation, but it is unclear how a stationary clip holder *acquires* anything. This is even more evident because the held portion of the clip is merely a plate with a hole, so there is nothing that can even arguably qualify as an "acquisition member." Further, there is no portion of the stationary clip holder where tissue is retained "within," and the Office Action does not explain or identify the portion of the clip holder that satisfies this claim feature. Applicant can find nothing in the Geitz disclosure where the clip holder "acquires tissue," much less acquires tissue "within", and therefore this limitation is not found in the cited reference. Because neither the first nor the second acquisition members are taught by the Geitz reference, the rejection under 35 U.S.C. §102(b) is properly withdrawn.

**along a longitudinal axis**

Claim 44 calls for the apposition of the first and second acquisition members **along a longitudinal axis**. While the Office Action conveniently adds a horizontal line to FIG. 6 in the illustration above and labels it "longitudinal," the direction of the line is "radial" and not longitudinal. There is nothing in the Geitz disclosure that would substantiate the Office Action's position that the radial line is "longitudinal," and thus even if the clip holders could qualify as first and second acquisition members, they are not aligned as required by Claim 44 and a rejection for anticipation cannot be sustained. If the Office Action has support in the record that demonstrates that the clip holders 31, 34 are apposed along a **longitudinal axis**, Applicant respectfully requests that the Office

Action identify what the "axis" corresponds to and where this can be found in the reference. Absent some expressed teaching in the reference, the rejection under 35 U.S.C. §102(b) must be withdrawn.

#### **Claim 50**

Claim 50 depends from Claim 44, and is allowable on this basis. Moreover, Claim 50 includes the feature of "drawing tissue **into** each of the first and second acquisition members via a vacuum force created **in an opening in each of the members**." As stated above, neither of the clip holders 31,34 asserted by the Office Action to be first and second acquisition members can draw tissue **into** the clip holders, so this claim is not met by the cited reference. Further, Claim 50 requires that each acquisition member have an opening that communicates a vacuum force. The Office Action cites only to a paragraph in Geitz spanning columns 5 and 6, which sets forth the following:

*"The third lumen in tube 21 is a vacuum supply lumen 27 which is in fluid communication with a vacuum source (not shown) at a proximal end of clipping device 20 and with suction ports 29 disposed on base 30 of tissue clip magazine 22. Sealed ducts (not shown), disposed below base 30, create a fluid communication between vacuum supply lumen 27 with suction ports 29.*

Thus, the only "openings" that communicate a vacuum force are suction ports 29 on the base 30, which is not on either of the structures asserted by the Office Action to be the first and second acquisition members. The Office Action offers no explanation as to how this limitation is met and how the purported first and second acquisition members of Geitz has suction ports. In view of the foregoing, the features of Claim 50 are properly deemed to be not present in the purported anticipatory reference, and the Claim is separately patentably distinguishable over the cited prior art reference and is allowable on this independent basis.

#### **Claims 51 & 52**

Claim 51 recites the feature whereby tissue is adhered simultaneously to the first and second acquisition members, and Claim 52 recites that the tissue is adhered

sequentially. Geitz discloses only the one system in which a tissue fold is clamped together. There is no explanation in the Office Action as to how the disclosure of Geitz satisfies **both** the simultaneous and sequential limitations by virtue of the single disclosed system, and Applicant respectfully submit that an anticipation rejection requires the Office Action to specifically and expressly demonstrate where the claimed feature is present in the purported anticipatory reference. Therefore, the rejection of Claims 51 and/or 52 is unsound on this independent basis and is properly withdrawn.

### **Conclusion**

There are no outstanding valid rejections of pending Claims 44 – 52, and therefore Applicant respectfully submits that the application is in condition for allowance and early notification of same is requested. If the Examiner believes that a telephone conference will further the prosecution of this application, the Examiner is invited to contact the undersigned at the number below.

The Commissioner is authorized to charge any deficiencies or fees in connection with this amendment to Deposit Account No. 06-2425

Respectfully submitted,  
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